

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the pending claims and the following remarks.

Amendments to the Claims

Upon entry of the present amendment, claims 1, 3-5, and 7-16 will be pending in the present application. Claim 2 has been cancelled herein. Claim 1 has been amended.

No new matter has been added by way of these amendments because each amendment is supported by the present specification. For example, the amendment to claim 1 finds support in claim 2 as originally filed.

Applicants submit that the present Amendment is merely formal in nature, reduces the number of issues under consideration, and places the case in condition for allowance. Entry of the present amendment is proper to place the claims in better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues over the Prior Art

1) The Examiner has rejected claims 1-5 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Freedman '782 (US 5,186,782).

2) The Examiner has rejected claims 1-5 and 7-8 under 35 U.S.C. § 103(a) as being unpatentable over Freedman '782 in view of Argoitia et al. '936 (US 6,749,936).

3) The Examiner has rejected claims 9-16 under 35 U.S.C. § 103(a) as being unpatentable over Freedman '782 in view of Argoitia et al. '936 and further in view of Bergholts et al. '245 (WO 99/61245).

Applicants respectfully traverse, and reconsideration and withdrawal of these rejections are respectfully requested.

As amended, independent claim 1 recites:

A heat-shrinkable opaque white film comprising a core layer; and white back and front layers,

the core layer contains at least one selected from the group consisting of black, yellow, red, and brown pigments, and has a chromatic color with low transparency to light at wavelengths of 380 to 500 nm or an achromatic color,

wherein the film has been prepared by co-extruding back and front layers with a core layer and drawing the coextrudate, wherein *each of the front layer, the core layer, and the back layer independently comprises a heat-shrinkable film layer* (emphasis added).

In stark contrast, Freedman '782 fails to disclose that "the core layer contains at least one selected from the group consisting of black, yellow, red, and brown pigments." Furthermore, this constitution cannot be easily achieved in combination with the cited references and the knowledge in the art.

Furthermore, according to Freedman '782, shrink film consists of "stretched, unannealed films" (col. 1, lines 59-60). However, the film described in Freedman '782 may be "annealed or heat-set" (col. 7, lines 5-9). Therefore, although the Examiner insists that the shrink film (heat-shrinkability film) is described in Freedman '782, the film described in Freedman '782 is clearly different from a heat-shrinkable opaque white film of the present invention.

Moreover, one of the features of the present invention is that all three layers are heat-shrinkable films. This feature is not described in the cited prior art. A usual film (for instance, one having an ink layer in either the surface layer, the center layer, or the back layer) has the layers with different shrinkage percentages. Therefore, after shrinkage, it is not possible to keep the constant shading and opalescent appearance. Under some specific situations, there is also a possibility that cracking and the like occur. The film of the present invention successfully solved this problem according to the composition as recited in claim 1.

Accordingly, the present invention is not anticipated by Freedman '782 since the reference does not teach or provide for each of the limitations recited in the pending claims.

In addition, a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be disclosed by the prior art or known in the art. As discussed above, Freedman '782, alone or in view of the other cited references, fails to disclose all the claim limitations of independent claim 1, and those claims dependent thereon. Therefore, withdrawal of the outstanding rejection is respectfully requested.

For the reasons given above, the combination of references does not render the present invention obvious because the cited references or the art as a whole do not disclose at least one feature of the present invention and its effects. Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Any contentions of the USPTO to the contrary must be reconsidered at present.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 1, 3-5, and 7-16 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink (Reg. No. 58,258) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By  #43575

Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicants